

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 12-16 are present active in this application, Claims 1-11 having previously been canceled.

In the outstanding Office Action, Claims 12-14 were rejected under 35 USC §103(a) as being unpatentable over Salmela et al (U.S. Patent No. 6,181,938) in view of Witter (U.S. Patent No. 6,073,035); and Claims 15-16 were rejected under 35 USC §103(a) as being unpatentable over Salmela et al in view of Witter and further in view of Jeong (U.S. Patent No. 6,421,539).

Applicants respectfully traverse the outstanding grounds for rejection on the basis that a prima facie case of obviousness has not been made. As noted in MPEP § 2142 "...the prior art reference (or references when combined) must teach or suggest **all** the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." In the present instance, the prior art clearly does not teach or suggest all the claim limitations recited in Claims 12-16.

In particular, as previously explained in the amendment filed March 3, 2004, as shown in Applicants' Fig. 2, steps performing location registration stage, i.e., steps 114, 118 and 120, are performed after steps performing base station acquisition, i.e., steps 102 and 104. Thus, it is clear from Applicants' disclosure that location registration is a different and distinct functionality relative to base station acquisition. The cited art fails to teach the claimed feature of "a controller configured to disable the receiver for a first time period when the receiver does not receive the acknowledge signal within a second time period of the

transmission of the location registration request signal and to enable the receiver when the first time period elapses,” and thus the outstanding rejection is not in compliance with MPEP § 2142

On the contrary, at most the Witter steps 56 and 58 shown in Fig. 2 of Witter correspond to steps 102 and 104 respectively Applicants’ Fig. 2, i.e., Witter’s steps 56 and 58 are directed to base station acquisition and not location registration. While Witter may reduce the power consumption of the RX section, CPU and MSM, Applicants’ invention reduces the power consumption of a transmitter in addition to a receiver.

At a location registration stage, a mobile station transmits a location registration request signal to an acquired base station and receives from the base station an acknowledge signal usually within 1 or 2 seconds. However, as described in "BACKGROUND OF THE INVENTION" of the present invention, there are areas where reverse signals from a mobile station are hard to receive whereas forward signals from a base station are easy to receive. If the mobile station does not receive the acknowledge signal in these areas, the mobile station continues in vain to transmit location registration request signals. Generally, transmitters consume much more electricity than receivers, and thus the problem addressed by Applicants is different, and the solution disclosed and claimed by Applicants has considerable significance neither taught nor rendered obvious by Witter.

According to the claimed invention, the controller disables the receiver for a first time period when the receiver does not receive the acknowledge signal within a second time period of the transmission of the location registration request signal and to enable the receiver when the first time period elapses. Therefore, Applicants’ invention achieves reducing the power consumption of the receiver at the location registration stage and results in reducing

the power consumption of the transmitter, unlike the case of Witter. Accordingly, it is respectfully submitted that Witter fails to cure the deficiencies of the other applied references.

The outstanding Office Action completely fails to address the above distinction between base station acquisition and location registration or the advantageous effect achieved by the claimed invention. On the contrary, the outstanding Office Action treats the two functionalities as being the same. This is evident from the statement at five lines from the bottom of page 2 of the Official Action that “Salmela et al. fails to teach step for prohibiting power supply to the receiving section if the ACK signal is not received within a predetermined period of time.” The Official Action fails to acknowledge that Salmela et al. additionally does not teach “to disable the receiver for a first time period when the receiver does not receive the acknowledge signal within a second time period of the transmission of the location registration request signal and to enable the receiver when the first time period elapses.” The Official Action seeks to remedy the stated deficiency by the Witter teaching of power down when an acknowledgement of base station acquisition is not received, but as noted, the acknowledgement of base station acquisition is different from an acknowledgment of a location registration request, and further the difference has operational significance, as above noted. Since Witter is silent in regard to treatment of a failure to receive an acknowledgment of a location registration request, it is respectfully submitted that Witter clearly does not cure the deficiencies of Salmela et al, and the outstanding grounds of rejection of Claims 12-16 are traversed.

Applicants further take issue with the rejection of Claim 16 which is based on taking of judicial notice. MPEP 2143.03 states “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art,” yet no prior art is cited in the rejection of Claim 16. The U.S. Supreme Court requires “substantial

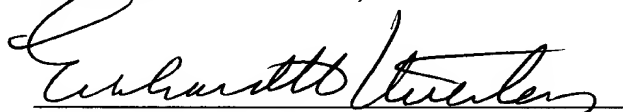
Application No. 09/664,855
Reply to Office Action of April 9, 2004

evidence" in support of finding of obviousness. Dickinson v. Zurko, US 50 USPQ2d 1930 (U.S. SupCt 1999). The Federal Circuit has held that "the USPTO's assessment that such a feature is "basic knowledge" or "common sense" is not substantial evidence." In re Zurko, 59 USPQ2d 1693 (Fed. Cir. 2001). Accordingly, the rejection of Claim 16 is further traversed as not being based on substantial evidence.

Consequently, in view of the present amendment, and in light of the above comments, it is respectfully submitted that Claims 12-16 are in condition for allowance, and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Eckhard H. Kuesters
Attorney of Record
Registration No. 28,870

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/03)

I:\ATTY\EHK\AMEND-RESPONSES\0039\19S\197452US-AM1.DOC